

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 12, 2005. In the Office Action, Claims 1-39 are pending and the Examiner rejects Claims 1-39. Applicants note with appreciation the Examiner's acceptance of the drawings filed on December 13, 2001. Applicants respectfully request reconsideration and favorable action in this case.

A. The Claims are Allowable over the cited References

The Examiner rejects Claims 1, 11, 15-16, 18-19, and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0035425 issued to Abdollahi et al. ("Abdollahi") in view of U.S. Patent Application Publication No. 2003/0081556 issued to Woodall ("Woodall"). Additionally, The Examiner rejects Claim 20 under 35 U.S.C. § 103(a) as being unpatentable over *Abdollahi* in view of *Woodall*, and further in view of U.S. Patent No. 6,700,901 issued to Shaffer et al. ("Shaffer"). Because the proposed combinations do not disclose, teach, or suggest each and every feature of Applicants' claims, Applicants respectfully traverse the rejection of the claims and request reconsideration and favorable action.

Independent Claim 1, which has been rejected over the *Abdollahi-Woodall* combination, recites:

A method for recovering a communication session after failure of an endpoint, comprising:
establishing a communication session between a first endpoint and a second endpoint;
receiving keep alive signals from the first endpoint;
detecting an interruption in the keep alive signals;
maintaining a connection with the second endpoint after the interruption; and
reestablishing the communication session between the first endpoint and the second endpoint if the keep alive signals resume within a predetermined time period

Whether considered alone or in combination, neither *Abdollahi* nor *Woodall* disclose, either expressly or inherently, each and every element of independent Claim 1.

For example, Applicants respectfully submit that the proposed *Abdollahi-Woodall* combination does not disclose, teach, or suggest “maintaining a connection with the second endpoint after the interruption” and “reestablishing the communication session . . . ,” as recited in Claim 1. In the Office Action, the Examiner acknowledges that the recited features and operations are absent from *Abdollahi* and instead relies upon *Woodall*. Applicants respectfully submit, however, that *Woodall* also does not disclose the recited features and operations. Rather, *Woodall* discloses a switched network that “includes a network manager, a plurality of switches, a plurality of network interface cards and a plurality of processors (host).” (Page 1, paragraph 9). As disclosed in *Woodall*, “a typical network manager will only detect a fault during a communication session or when the network manager loses communication with a portion of the network that includes these devices.” (Page 1, paragraph 5). “As a result, user data may be lost or delayed.” (Page 1, paragraph 5). To prevent such data loss or delay, the network devices of the *Woodall* system (i.e., switches, network interface cards, and processors) “generate fault information (e.g. reports or messages).” (Page 1, paragraph 9). “The network manager receives the fault information and is then able to isolate and resolve the fault information in real-time prior to the initiation of a communication session.” (Page 1, paragraph 9). Accordingly, while *Woodall* discloses that “standardized protocols and algorithms implemented in the switch, will be used by the switch to attempt to [recover] from the fault” within a time frame monitored by a timer,” *Woodall* explicitly discloses that such operations are performed **“prior to the initiation of a communication session.”** (Page 4, paragraph 38; Page 1, paragraph 9). Accordingly, *Woodall* cannot be said to disclose, teach, or suggest “maintaining a connection with the second endpoint after the interruption” and “reestablishing the communication session . . . ,” as recited in Claim 1.

As a further example of the deficiencies of the *Abdollahi-Woodall* combination, Applicants respectfully submit that neither *Abdollahi* nor *Woodall* disclose, teach, or suggest the functionality described in Claim 1 as being performed with respect to first and second endpoints (i.e., “receiving keep alive signals from the first endpoint” and “maintaining a connection with the second endpoint after the interruption”). Rather, the features described in *Abdollahi* and *Woodall*, as relied upon by the Examiner, pertain to intermediary devices. For example, *Abdollahi* discloses that a “manager node 212 illustratively periodically transmits an SMMP “keep-alive” message for each open session to the respective router node 230 or group/subgroup

of router nodes 230 corresponding to the message.” (Page 10, paragraph 112). Likewise, *Woodall* discloses, as discussed above, that a switch “is responsible for switching communications traffic through the network” and that the “communications traffic may be generated from an end-user application, a peripheral device or another communications device within the network.” (Page 2, paragraph 25). Thus, the functionality of *Woodall* that includes “generat[ing] fault information” and “attempt[ing] to [recover] from the fault” is also performed by an intermediary device and does not apply to an endpoint. (Page 1, paragraph 9; Page 4, paragraph 38).

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1, together with Claims 2-5 that depend from Claim 1.

Independent Claims 6, 16, 26, 32, 36, and 39 include certain features and operations that are analogous to the features and operations recited in Claim 1. For example, Claim 6 recites “receiving keep alive signals from the first endpoint” and “maintaining a connection with the second endpoint after the interruption.” As a further example, Claim 16 recites “an interface operable to receive keep alive signals from a first endpoint . . .” and “a processor operable to . . . maintain a connection with the first endpoint after the interruption.” Accordingly, for reasons analogous to those discussed above with regard to Claim 1, Applicants submit that the proposed *Abdollahi-Woodall* combination (whether or not combined with *Rahman*) does not disclose, teach, or suggest the features of independent Claims 6, 16, 26, 32, 36, and 39.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 6, 16, 26, 32, 36, and 39, together with Claims 7-10, 17-25, 27-31, 33-35, and 37-38 that depend from Claims 6, 16, 26, 32, and 36, respectively.

With regard to independent Claim 11, Applicants respectfully submit that the features and operations recited in the claim are also not disclosed, taught, or suggested by the proposed *Abdollahi-Woodall* combination. For example, Applicants respectfully submit that the proposed *Abdollahi-Woodall* combination does not disclose “receiving from a user of the first endpoint a message to reestablish the communication session” and “in response to the message, reestablishing the communication session between the second endpoint and the user of the first

endpoint,” as recited in Claim 11. In the Office Action, the Examiner specifically relies upon *Woodall* for disclosure of the recited elements. Applicants have shown above, however, that *Woodall* is limited to a system for detecting failure in a switch or other intermediary network device. Specifically, *Woodall* discloses that a switch includes “client/agent software or logic” that operates to “implement routines that facilitate the identification, reporting and isolation of faults at various points in the network.” (Pages 3-4, paragraphs 27-28). Accordingly, while the switch may operate using standardized protocols and algorithms implemented in the switch . . . to attempt to [recover] from the fault” (Page 4, paragraph 38), there is certainly no disclosure in *Woodall* of “receiving from a user of the first endpoint a message to reestablish the communication session,” as recited in Claim 11. As a result, there can also be no disclosure of “in response to the message, reestablishing the communication session between the second endpoint and the user of the first endpoint,” as recited in Claim 11. The deficiency of *Woodall* with respect to this latter element of Claim 11 is further demonstrated by *Woodall*’s disclosure that the fault information is received “in real-time prior to the initiation of a communication session.” (Page 1, paragraph 9).

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 11, together with Claims 12-15 that depend from Claim 11.

B. The Proposed *Abdollahi-Woodall* and *Abdollahi-Woodall-Rahman* Combinations are Improper

Furthermore, Applicants respectfully submit that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention to modify or combine *Abdollahi* with *Woodall* and/or *Rahman* in the manner the Examiner proposes. Applicants’ claims are allowable for at least this additional reason.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention

taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Abdollahi-Woodall* and *Abdollahi-Woodall-Rahman* combinations do not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembicza*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* **Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). See also *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (**holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine**); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "*The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*" M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id. See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembicza*k, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. The Analysis

According to the Examiner, “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the communication session of *Abdollahi* by maintaining the session while attempting to establish the session between the endpoints if the keep alive signals resume within a predetermined time period as shown by *Woodall*.” (Office Action, pages 4 and 13). The purported motivation provided by the Examiner is “[to] enable the keep-alive session of *Abdollahi* to recover from faults without the need to re-initialize while providing necessary time to recover from the fault, in the event that the session is unable to recover from the fault immediately (*Woodall*, paragraph [0038]).” (Office Action, pages 4 and 13). With regard to independent Claims 6, 26, 36, and 39, the Examiner further provides that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the communication session of *Abdollahi* and *Woodall* by transferring the communication session with the second endpoint from the first endpoint to a third endpoint as shown by *Rahman* . . . [to] enable a viable connection through a third endpoint, with a target network that was lost because of the session failure between the first endpoint and the second endpoint. (*Rahman*; column 2, lines 54-57)” (Office Action, page 14).

It appears that the Examiner has merely proposed alleged advantages of combining *Abdollahi* with *Woodall* and *Rahman*, respectively (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portions of *Woodall* and *Rahman* that tout an advantage of their respective systems, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the broadcast satellite network disclosed in *Abdollahi* with the switching functionality disclosed in *Woodall* and/or the wireless bridge functionality of *Rahman*. In other words, the alleged advantage of the systems disclosed in *Woodall* and *Rahman* do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the particular techniques disclosed in *Woodall* and/or *Rahman* with the cited disclosure in *Abdollahi*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1.

Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

It certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular techniques disclosed in *Woodall* and/or *Rahman* with the broadcast satellite network of *Abdollahi* in the manner proposed by the Examiner.² Applicants respectfully submit that the Examiner's attempt to modify or combine *Abdollahi* with *Woodall* and/or *Rahman* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Abdollahi* with *Woodall* and/or *Rahman* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1-39.

² If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

CONCLUSION

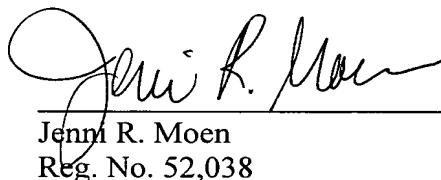
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorneys for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants enclose a check in the amount of \$180.00 for filing an Information Disclosure Statement. Applicants believe that no other fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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